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Independent claim 21 recites "a server that is accessible over the Internet by a subscriber using a wireless communications device; and a software application that instructs the server to transmit parking data over the Internet to the wireless communications device of the subscriber, wherein the parking data can be rendered by the subscriber using the wireless communications device as a substantially real-time representation indicating an occupancy condition of an available parking lot, and the occupancy condition changes according to presence and absence of vacant parking spaces within the available parking lot."

Independent claim 35 recites "a server that is accessible over the Internet by a display device; and a software application that instructs the server to transmit parking data over the Internet to the display device, wherein the parking data can be rendered by the display device as a substantially real-time representation indicating an occupancy condition of an available parking lot, the occupancy condition changes according to presence and absence of vacant parking spaces within the available parking lot, and the real-time representation comprises a map identifying a location of at least one available parking space within an available parking lot having an occupancy condition corresponding to at least one vacant parking space being present within the available parking lot."

In stark contrast, Tomer is directed to a parking system in which a user pays only for the time that a vehicle occupies a parking location.² To accomplish the "real time parking" concept described in Tomer, a user notifies a central control unit upon entering and leaving a parking zone.³ Specifically, after a user parks a vehicle, the user provides the central control unit with a zone identification and a vehicle unique indicia.⁴ Upon removing the vehicle from the parking location, the user provides the central control unit with the vehicle unique indicia.⁵ The central control unit then assesses the user a fee according to the duration of time the vehicle occupied the parking location.⁶ Tomer teaches that users employ standard communication technology systems so that no additional hardware is required inside the vehicle.⁷

² See Tomer at col. 2, ll. 60-67

³ Id. at col. 3, ll. 1-30.

⁴ Id. at col. 3, ll. 7-13.

⁵ Id. at col. 3, ll. 18-30.

⁶ Id. at col. 3, ll. 35-45.

⁷ Id. at col. 1, ll. 50-53.

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According to Tomer, users are not required to notify the central control unit upon leaving the parking location, but they are encouraged to do so as follows:

For parking locations that are in high demand, short time limits and/or higher rates are imposed on users that occupy these high demand parking locations. When parking in the high demand locations, the user is urged to notify the remote central control unit when the user vacates the location. If the user does not notify on vacating the location, not only is the user charged for the full time limit allowed, but also an additional fee may be added to the toll parking charge.⁸

Tomer states that the reason for encouraging users to notify the central control unit upon leaving is as follows:

The purpose of mandatory vacate notification is to allow the remote central control unit to monitor the number and location of the high demand toll parking locations. Further, users can access the availability of the high demand parking locations through the remote central control unit, thereby providing easier access by users to available toll parking locations... The remote central control unit continuously gathers extensive data on parked vehicles and the influx and departure of vehicles from the controlled parking areas. The data can be used for informing other drivers of parking location availability as described above, as well as statistics of parking location use to improve city parking zone configurations.⁹

The Examiner correctly notes that Tomer does not show the claimed server and the claimed software application.¹⁰ Despite admitting such deficiencies, the Examiner nevertheless alleges that it would have been obvious to include the claimed server and software application in the system of Tomer.¹¹ Applicant respectfully traverses this allegation.

⁸ *Id.* at col. 3, ll. 50-60.

⁹ *Id.* at col. 3, ll. 60-64 and col. 4, ll. 9-15.

¹⁰ Office Action at p. 2.

¹¹ *Id.* at pp. 2-3.

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The Examiner's rationale underlying the §103(a) rejection appears to be based primarily on two selected portions of Tomer. Namely, the portion at column 3, lines 31-36, which reads as follows:

For users with cellular telephones, cellular Internet communicators, or palm PCs, the notification of the remote central control unit is as simple as entering a series of numbers in the communication device memory for transfer to the remote central unit.

This portion is fundamental to the ground of rejection that "the claimed wireless communications device is met by the users' communications devices (see: column 3, lines 31-36)."¹²

And, the portion at column 3, line 64-66, which reads as follows:

The central control unit may provide such information via the Internet with domain names such as: Call2park.com, RealTimeParking.com, PhotoParking.com, Wapark.net or Parkulator.com.

This portion is fundamental to the ground of rejection that "it would have been obvious that a server would have been included in the system of Tomer, since Tomer does state that information concerning parking is communicated to a user via the Internet (column 3, line 64 et seq), which thereby implies that it would have been necessary for a server to be involved in the system of Tomer in order for the transfer of information over the Internet to occur."¹³

Even assuming *arguendo* that the portions of Tomer at column 3, lines 31-36 and column 3, lines 64-66 could be considered, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 21 and 35. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the system of Tomer to include the claimed server and software application or to combine Tomer with any other teachings. Second, given the described operation of Tomer (e.g., optional notification), there would be no reasonable expectation of success to modify Tomer to include the claimed server and software operation.

¹² *Id.* at p. 2.

¹³ *Id.* at pp. 2-3.

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Finally, Tomer alone or in combination with the knowledge generally available to one of ordinary skill in the art, fails to teach or suggest all the claim limitations.

Regarding independent claim 35, in particular, the Examiner alleges that use of a visual display showing available parking locations is well known in the art.¹⁴ Applicant traverses the Examiner's allegation and requests the Examiner to cite a reference to support this position.

Moreover, Applicant submits that the features described in the portions of Tomer at column 3, lines 31-36 and column 3, lines 64-66 **do not qualify as prior art** and should not be considered with respect to claims 21-40, since such features were not disclosed or adequately supported by a proper disclosure in provisional application 60/145,246. Indeed, such features were first introduced in the nonprovisional application filed July 20, 2000. For the Examiner's convenience, Applicant has attached hereto a marked up version of columns 3 and 4 of the Tomer patent that identifies (by underlining) subject matter first introduced in the nonprovisional application filed July on 20, 2000. Applicant also has attached a copy of provisional application 60/145,246 as filed on July 26, 1999.

Applicant submits that granting the effective filing date of the provisional application under 35 U.S.C. §119(e) to the features that were first introduced in the nonprovisional application would be contrary to the spirit of 35 U.S.C. §119(e) and 35 U.S.C §112, first paragraph. Namely, §119(e)(1) states:

An application for patent filed under §111(a) or §363 of this title **for an invention disclosed in the manner provided by the first paragraph of §112 of this title** in a provisional application filed under §111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, **as to such invention**, as though filed on the date of the provisional application filed under §111(b) of this title, if the application for patent filed under §111(a) or §363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application (emphasis added).

¹⁴ See Office Action at pp. 3-4.

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And, 35 U.S.C. §112, first paragraph states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Here, the features described at column 3, lines 31-36 and column 3, lines 64-66 of Tomer were not disclosed or adequately supported by the provisional application in the manner prescribed by 35 U.S.C. §112, first paragraph. For at least this reason, among others, Applicant submits that the features described at column 3, lines 31-36 and column 3, lines 64-66 of Tomer are not entitled to the benefit of the July 26, 1999 filing date of the provisional application. Consequently, such features do not qualify as prior art because claims 21-40 have an effective filing date of no later than September 28, 1999. Accordingly, it is improper for the Examiner to rely on the features described in the portions of Tomer at column 3, lines 31-36 and column 3, lines 64-66 as the basis for any ground of rejection.

In view of the above, Applicant submits that Tomer, alone or in combination with the knowledge generally available to one of ordinary skill in the art, fails to teach or suggest the claimed features of independent claims 21 and 35. Applicant submits that independent claims 21 and 35 are allowable, for at least this reason, and that dependent claims 22-34 and 36-40 are allowable by virtue of their dependency, as well as on their own merits.

Information Disclosure Statements

Applicant again requests initialed PTO-1449 forms indicating that the references submitted with the six (6) previously filed Information Disclosure Statements have been considered.

Proposed Drawing Change

Applicant again requests approval of the previously filed proposed drawing change.

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CONCLUSION

Applicant submits that this application is in condition for allowance and requests favorable action in the form of a Notice of Allowance.

Respectfully submitted,

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